

Atty. Dkt. No.: 059314-0401

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:

Xin Jiang et al.

Title:

LIPID-ASSOCIATED

MOLECULES

Appl. No.:

10/534,579

Filing Date:

May 11, 2005

Examiner:

Unassigned

Art Unit:

Unassigned

RENEWED PETITION UNDER 37 C.F.R. §1.47(a)

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Sir:

Further to the Decision on Petition (copy attached), mailed July 14, 2006, in connection with the above-captioned application, reconsideration is hereby requested of Applicant's original request. While the shortened statutory period for response has expired, filed herewith is a Petition for a two month extension of time to extend the period for response to November 14, 2006. Accordingly, this response is timely filed.

In support of this request, Applicants submit the Declaration of Xin Jiang, and the initialed Declaration of Jaji Murage.

With respect to inventor Kimberly Gietzen, Applicants submit the attached Petition.

Kimberly Gietzen

Applicants have performed further internet searches (attached) to find Ms. Kimberly Applicants telephoned Ms. Gietzen at the telephone number on record (see Affidavit of Stella Walker). Applicants have sent two Fedex packages to Ms. Gietzen for signature (see copies attached) to the last known address on record. The documents were delivered, however, we have not received any signed documents to date.

139,00 OP

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Adjustment date: 11/16/2006 SZEWDIE1 11/15/2006 SZEWDIE1 00000095 10534579 02 FC:1464 -130.00 OP 11/15/2006 SZEWDIE1 00000095 10534579

02 FC:1464

130.00 OP

Atty. Dkt. No.: 059314-0401

In view of the foregoing, Applicants respectfully request that the previous petitions and requests to include Ms. Gietzen as a joint inventor of the above-identified application be granted.

In accordance with the Decision on Petition dated July 14, 2006, Applicants believe no fees are due with this Renewed Petition, except for a two month extension of time which is attached.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 CFR §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Please direct all correspondence to the undersigned attorney or agent at the address indicated below.

Respectfully submitted,

By Mich M. A.L.

Attorney for Applicants

Registration No. 34,717

Michele M. Simkin

Date

FOLEY & LARDNER LLP

Customer Number: 22428

Telephone:

(202) 672-5538

Facsimile:

(202) 672-5399

UNITED STATES PARENT AND TRADEMARK OFFICE

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

14 JUL 2006

Michele M. Simkin Foley & Lardner, LLP 3000 K Street, Suite 500 Washington, DC 20007

In re Application of

JIANG, et al.

Application No.: 10/534,579 PCT No.: PCT/US03/35946

Int. Filing Date: 10 November 2003

Priority Date: 13 November 2002

Atty. Docket No.: 039386-2266 059314-0401

For: LIPID-ASSOCIATED MOLECULES

DECISION ON PETITION

UNDER 37 CFR 1.47(a)

This decision is in response to the applicant's "PETITION UNDER 37 C.F.R. § 1.47(a)" filed 27 April 2006 in the United States Patent and Trademark Office (USPTO). As authorized the \$200.00 petition fee will be deducted from deposit account 19-0741.

BACKGROUND

On 10 November 2003, applicant filed international application PCT/US03/35946 which claimed priority to an earlier U.S. application filed 13 November 2002. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States was set to expire at midnight on 13 May 2005.

On 11 May 2005, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a First preliminary amendment and an Application Data Sheet.

On 27 February 2006, applicant was mailed a "Notification of Missing Requirements" (Form PCT/DO/EO/905) informing applicant that an executed oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required. Applicant was afforded two months to file the required response and advised that this period could be extended pursuant to 37 CFR 1.136(a).

On 27 April 2006, applicant filed the present petition under 37 CFR 1.47(a) to accept the filed declaration without the signature of joint inventors Xin Jiang, Hsin-Ru Chang and Kimberely J. Gietzen.

Application No.: 10/534,579

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(i), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. With the filing of the present petition and accompanying papers, applicant has satisfied items 1 and 3.

Regarding inventor Hsin-Ru Chang, applicant has also satisfied item 2 in that applicant has provided a first-hand account (declaration of Ms. Christine Arthur) of the nonsigning inventor's confirmation of delivery of a complete set of the application papers and an express refusal to execute the declaration. Therefore, it is proper to grant the petition as to Hsin-Ru Chang.

As to item (2) and inventors Jiang and Gietzen, Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) states, in part: Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47... The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as Internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should include a statement of facts. It is important that the statement contain facts as opposed to conclusions.

While applicant has included Federal Express tracking information for packages mailed to inventors Jiang and Gietzen, these sheets do not contain any receipt signature information. Thus, it is not possible to take the inventors' subsequent silence as a refusal to cooperate. Applicant states that directory assistance did not have a listing for these inventors at their last known addresses. However, it does not appear that any additional searching was performed to locate current contact information as listed above.

Regarding item (4), the filed declaration executed by inventor Murage is defective and is insufficient to satisfy the oath or declarations requirement of 35 CFR 371(c)(4) for entry into the

Application No.: 10/534,579

national stage in the United States of America. Specifically, the declaration submitted includes an alteration that has not been initialed and dated by inventor Murage. (See MPEP §605.04(a) and 37 CFR 1.52(c)). The published international application and filed application data sheet list the inventor's first name as "Jagi" while the declaration executed by the inventor has been altered and the first name spelled as "Jaji."

For the reasons stated above, it is not possible to grant applicant's petition at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Derek A. Putonen Attorney Advisor

Ahas

Office of PCT Legal Administration

Tel: (571) 272-3294 Fax: (571) 273-0459



Attorney Dkt. No.: 059314-0401

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:

Xin Jiang et al.

Title:

LIPID-ASSOCIATED

MOLECULES

Appl. No.:

10/534,579

Filing Date: May 11, 2005

Examiner:

Unassigned

Art Unit:

Unassigned

PETITION UNDER 37 C.F.R. § 1.47(a) – Kimberly Gietzen

Sir:

Pursuant to 37 C.F.R. § 1.47(a) and the guidelines set forth in M.P.E.P. § 409.03, a request is hereby made to include Kimberly Gietzen as a joint inventor of the above-identified application even though she has been unable to be located and/or refuses join in the application by signing an oath or declaration complying with 37 C.F.R. § 1.63. Below is a description of the pertinent facts explaining the refusal of Ms. Gietzen to join in the subject application, extensive internet searches, as well as her last known address.

1. The named inventors of the above-identified application are as follows:

Xin Jiang

Shanya D. Becha

Sean A. Bulloch

Hsin-Ru Chang

Narinder K. Chawla

Vicki S. Elliott

Brooke M. Emerling

Kimberly J. Gietzen

April J.A. Haflia

Alan A. Jackson

Amy E. Kable

Reena Khare

Soo Yeun Lee

Joseph P. Marquis

Jagi Murage

Anita Swarnakar

Yonghang G. Yang

- 2. The last known address of Kimberly Gietzen is: 691 Los Huecos Drive, San Jose, California 95123.
- 3. The following attempts were made to contact Ms. Gietzen to inform her that her signature was needed on a Declaration complying with 37 C.F.R. § 1.63 in connection with the above-identified application.

- a. On September 25, 2006, a copy of the Declaration complying with 37 C.F.R. § 1.63, was sent to Ms. Gietzen from Michele Simkin, attorney for the applicants, via Federal Express. A letter was included requesting that she return the signed documents by September 29, 2006. On October 30, 2006, a second copy of the September 21, 2006 letter and a second copy of the Declaration was sent to Ms. Gietzen's for signature. Also included in each package was a prepared return Federal Express label to ease Ms. Gietzen's return of the documents. A copy of the September 21, 2006 letter, Federal Express labels, and Federal Express tracking information (showing the packages were delivered) are attached. See Tab A.
- b. On October 9, 2006 and November 8, 2006, Stella Walker, a legal assistant employed by Foley and Lardner LLP, called Ms. Gietzen at the number on record and left a message on an answering machine for Ms. Gietzen to call regarding signing and returning the Declarations (see Affidavit of Stella Walker).
- c. As of the date of this petition, no signed documents regarding the above-captioned application have been received from Ms. Gietzen.
- 4. In view of the multiple requests made to Ms. Gietzen to execute the Declaration in connection with the subject application, and Ms. Gietzen's lack of responsiveness to these requests, it is apparent that Ms. Gietzen is unable to be located and/or is refusing to join in the subject application by executing the Declaration. Therefore, in accordance with 37 C.F.R. § 1.47(a), the undersigned petitions the U.S. Patent and Trademark Office to accept this Petition and the attached evidence to include Kimberly Gietzen as an inventor of this application.

The fee for the Petition of Kimberly Gietzen is \$130.00. A credit card payment form is enclosed. The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

The undersigned states declares further that all statements made herein are true and that all statements made herein on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

If there are any questions regarding the above, please contact the undersigned.

Respectfully submitted,

Date

FOLEY & LARDNER LLP

Customer Number: 22428

Telephone:

(202) 672-5538

Facsimile:

(202) 672-5399

Michele M. Simkin Attorney for Applicants

Registration No. 34,717

Attorney Docket No. 059314-0401

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:

Xin Jiang et al.

Title:

LIPID-ASSOCIATED MOLECULES

Appl. No.:

10/534,579

Filing Date:

05/11/2005

Examiner:

Unassigned

Art Unit:

Unassigned

AFFIDAVIT OF STELLA WALKER

I, Stella Walker, do hereby declare:

I am an employee of Foley & Lardner LLP and currently hold the title of Legal Assistant. My duties at Foley & Lardner LLP include preparing and acquiring the execution of Declarations and Assignments needed for the prosecution of patent applications.

I declare that I attempted to contact Ms. Kimberly Gietzen by telephone on October 9, 2006, at 1:00 p.m., there was no answer so I left a message to call me in regards to the Declaration being signed and returned. On November 8, 2006, at 7:55 a.m., I telephoned Ms. Gietzen and there was no answer. I left a message in regards to the Declaration being signed and returned. I have performed extensive internet searches to see if her telephone number and address has changed. I did not find any changes in her address.

The undersigned states declares further that all statements made herein are true and that all statements made herein on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Signature

Date



September 21, 2006

FOLEY & LARDNER LLP ATTORNEYS AT LAW

WASHINGTON HARBOUR 3000 K STREET, N.W., SUITE 5 WASHINGTON, D.C. 20007-514 202.672.5300 TEL 202.672.5399 FAX www.foley.com

WRITER'S DIRECT LINE 202.672.5538 msimkin@foley.com EMAIL

CLIENT/MATTER NUMBER 059314-0401

VIA FEDERAL EXPRESS DELIVERY

Kimberly J. Gietzen 691 Los Huecos Drive San Jose, CA 95123

Re:

U.S. National Stage of Application No.: PCT/US03/35946

Title: LIPID-ASSOCIATED MOLECULES

Inventor(s): Xin Jiang et al.

Our Ref.: 059314-0401 (prev. 039386-2266)

Incyte Ref.: PF-1618 PCT

Dear Ms. Gietzen:

We are the legal representatives for Incyte Corporation. We currently are in the process of entering the U.S. national phase of the above-identified international application. Enclosed for your review is a copy of the published international application.

We ask that you please sign and date the enclosed Declaration and Assignment, and return these documents to us in the enclosed self-addressed Federal Express envelope no later than **September 29, 2006**. Please keep the enclosed application for your records.

Please make any corrections and/or additions necessary on the Declaration and Assignment. If you make any changes to the name or address listed on the Declaration and/or Assignment, please place your initials beside the change.

We greatly appreciate your prompt attention to this matter. If you have any questions, please do not hesitate to contact me or my legal assistant, Stella Walker at 202-945-6094.

Very truly yours,

Michele M. Simkin

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Date/Time Activity Location Oct 31, 2006 10:04 AM Delivered 8:48 AM At dest sort facility SAN JOSE, CA 8:30 AM On FedEx vehicle SANTA CLARA, for delivery CA 8:14 AM At local FedEx SANTA CLARA, facility CA 7:02 AM At dest sort facility SAN JOSE, CA 4:23 AM Departed FedEx MEMPHIS, TN location Oct 30, 2006 9:55 PM WASHINGTON, Left origin 7:42 PM Picked up WASHINGTON, DC

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Source: Public Records > People, Business & Asset Locators > P-TRAK Person Locator - Nationwide

Terms: first-name (kimberly) and last-name (gietzen) and state (california) (Edit Search | Suggest Terms for My

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GIETZEN, KIMBERLY JEAN

THIS DATA IS FOR INFORMATIONAL PURPOSES ONLY

PERSON LOCATOR - P-TRAK

Name: GIETZEN, KIMBERLY JEAN

Also Known As:

FISH, KIMBERLY JEAN; GIETZEN, KIMBERLY J

Social Security Number: 562-63-XXXX

Address:

691 LOS HUECOS DR SAN JOSE, **CA** 95123-4632 Address Updated: 12/1/1998

Previous Addresses:

PO BOX 763

BONITA, CA 91908-0763

Address Updated: 11/13/2000

933 WILLOWLEAF DR APT. 608 SAN JOSE, **CA** 95128-3674 Address Updated: 11/13/2000

1155 E 2100 APT. 336

SALT LAKE CITY, UT 84106-6801 Address Updated: 7/18/2001

Birthdate: 7/1968

Telephone: 578-3280 しょいり

On File Since: 1/1/1988

Source: Public Records > People, Business & Asset Locators > P-TRAK Person Locator - Nationwide 🗓

Terms: first-name (kimberly) and last-name (gietzen) and state (california) (Edit Search | Suggest Terms for My

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View: Full

Date/Time: Wednesday, October 18, 2006 - 12:11 PM EDT

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Terms: first-name (kimberly) and last-name (gietzen) and state (ca) (Edit Search | Suggest Terms for My Search)

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GIETZEN, KIMBERLY JEAN

THIS DATA IS FOR INFORMATIONAL PURPOSES ONLY

PERSON LOCATOR - P-TRAK

Name: GIETZEN, KIMBERLY JEAN

Also Known As:

FISH, KIMBERLY JEAN; GIETZEN, KIMBERLY J

Social Security Number: 562-63-XXXX

Address:

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691 LOS HUECOS DR SAN JOSE, **CA** 95123-4632 Address Updated: 12/1/1998

Previous Addresses:

PO BOX 763 BONITA, **CA** 91908-0763 Address Updated: 11/13/2000

933 WILLOWLEAF DR APT. 608 SAN JOSE, **CA** 95128-3674 Address Updated: 11/13/2000

1155 E 2100 APT. 336

SALT LAKE CITY, UT 84106-6801 Address Updated: 7/18/2001

Birthdate: 7/1968

Telephone: 578-3280

On File Since: 1/1/1988

Source: Public Records > People, Business & Asset Locators > P-TRAK Person Locator - Nationwide [1]

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Date/Time: Thursday, October 26, 2006 - 12:29 PM EDT

Source: Public Records > People, Business & Asset Locators > ALLFND Combined Person Locator Files [i]

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GIETZEN, KIMBERLY JEAN

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PERSON LOCATOR - PSRCH2

Name: GIETZEN, KIMBERLY JEAN

Former Name:

FISH, KIMBERLY JEAN

Social Security Number: 562-63-XXXX

Address:

691 LOS HUECOS DR SAN JOSE, **CA** 95123 Address Created: 1/1999

Previous Addresses:

10689 SAUTERNE PL SAN DIEGO, **CA** 92131 Address Created: 12/2004

1966 BROADMOOR ST SALT LAKE CITY, UT 84108 Address Created: 11/1999

933 WILLOWLEAF DR APT 608 SAN JOSE, CA 95128 Address Created: 5/1998

Source: Public Records > People, Business & Asset Locators > ALLFND Combined Person Locator Files [1]

Terms: first-name (kimberly) and last-name (gietzen) and state (california) (Edit Search | Suggest Terms for My

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7 Search Results for Kimberly Gietzen found by US

Search Suggestions K. Giet, CA

SEARCH

Name, Age City, State

Kimberly Gietzen, 38 Bonita CA

Kimberly Gietzen, 38 **Bonita CA**

Kimberly Gletzen, 38 **Emeryville CA**

San Diego CA Kimberly Gietzen, 38

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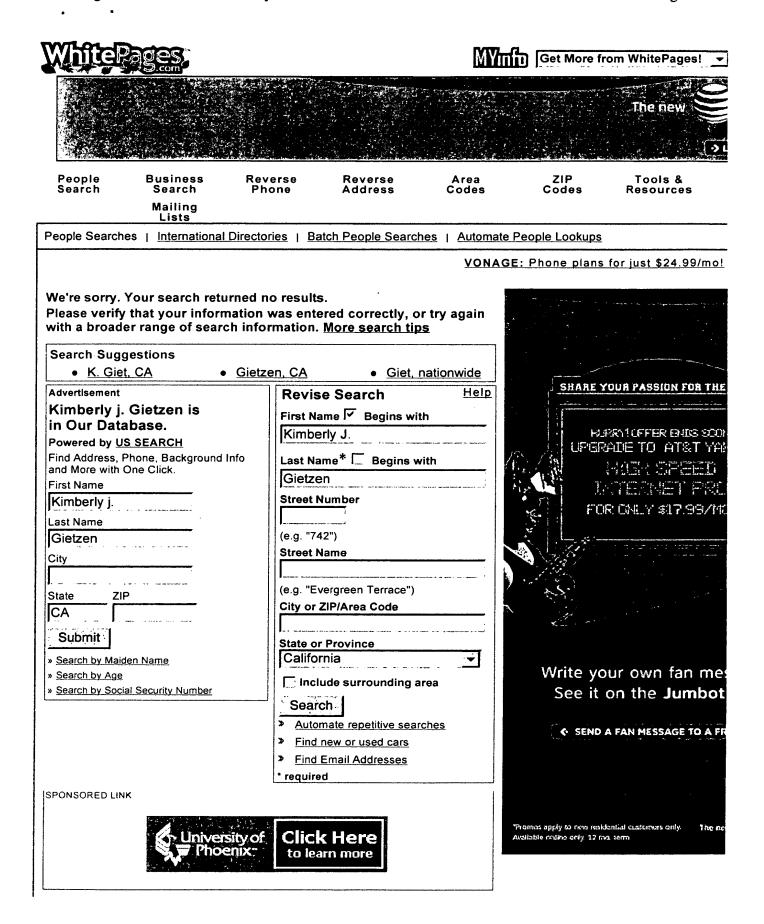
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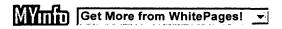
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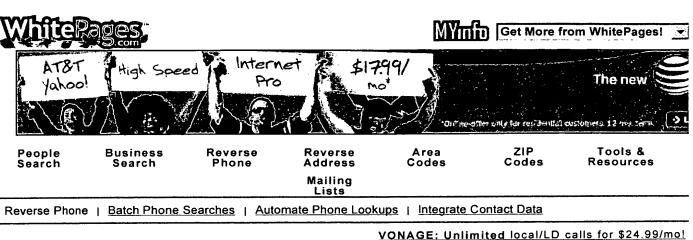
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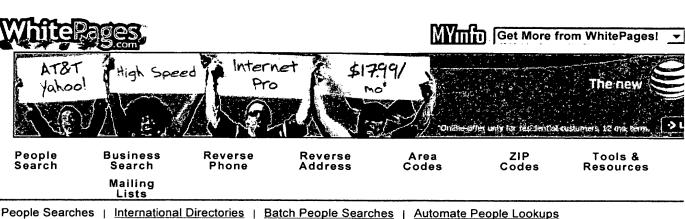
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